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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,668	01/26/2004	Huitao Liu	1033-LB1007	8818
60533	7590	05/31/2006	EXAMINER	
TOLER SCHAFFER, LLP 5000 PLAZA ON THE LAKES SUITE 265 AUSTIN, TX 78746			REGO, DOMINIC E	
			ART UNIT	PAPER NUMBER
			2618	

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/764,668	LIU, HUITAO	
	Examiner	Art Unit	
	Dominic E. Rego	2684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>06/03/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 are rejected under 35 U.S.C. 102(e) as being anticipated by Croome et al. (*US Patent Application Publication #20040014423*).

Regarding claim 1, Croome teaches a terminal having private content stored in a memory, the terminal comprising:

at least one smart card having IMSI information (*Page 1, paragraph 0005*:
Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), which uniquely identifies the subscriber) or an MSISDN/IMSI combination, that uniquely identifies the card; and

a security function (*PIN value*) that associates the private contents stored in the terminal memory with the IMSI or MSISDN/IMSI combination on the smart card to grant access to the private content only to the authorized smart card (*Paragraph 0006*).

Regarding claims 2,12, and 20, Croome teaches the terminal, wherein the

terminal comprises a mobile telephone (*Paragraph 0006*).

Regarding claims 3 and 13, Croome teaches the terminal, wherein the terminal comprises a communicator (*Paragraph 0005 and this is inherent to have a communicator to all the mobile phone*).

Regarding claims 4 and 14, Croome teaches the terminal, wherein the smart card comprises a SIM (*Paragraph 0005*).

Regarding claim 5, Croome teaches the terminal, wherein the terminal further comprises IMSI/MSISDN associated with the private content, whereby the security function (*PIN value*) denies access to the private content to a smart card having unauthorized IMSI/MSISDN and grants access to the private content to a smart card having authorized IMSI/MSISDN (*Paragraphs 0005 and 0006*).

Regarding claims 6,7,10,11,16 and 18, Croome teaches the terminal, wherein the private content comprises discreet items, and the private content IMSI/MSISDN is associated with each discreet item (*Paragraph 0005: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), which uniquely identifies the subscriber, a subscriber private-key, a copy of the user PIN code, a user phone book same as group of contact information, and other data which can be discreet items such as MP3 file, a jpeg image, or a ring tone*).

Regarding claim 8, Croome teaches the terminal, wherein the terminal comprises a GSM terminal (*Paragraph 0005*).

Regarding claim 9, Croome teaches a method for controlling access to private content stored in a GSM/SIM mobile terminal, the method comprising the steps of:

providing the private content (*PIN code, a user phone book, and other data which can be anything else*) with IMSI/MSISDN information (*Paragraph 0005*);

associating the private content IMSI/MSISDN with the IMSI/MSISDN of a SIM (*Paragraph 0005: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), which uniquely identifies the subscriber, a subscriber private-key, a copy of the user PIN code, a user phone book same as group of contact information, and other data which can be discreet items such as MP3 file, a jpeg image, or a ring tone*);

comparing the IMSI/MSISDN of the private content (*PIN code*) with the IMSI/MSISDN of the SIM (*user must enter their PIN for comparison by the SIM with the stored PIN value*); denying access to the private content when the comparison result is negative; and granting access to the private content when the comparison result is positive (*Paragraph 0006*).

Regarding claim 15, Croome teaches a system for preventing unauthorized access to private content (*user PIN code*) stored in the internal memory of a mobile terminal, the system comprising:

mobile equipment that accesses a wireless network by radio transmission and reception using 3GPP protocols (*Paragraph 0001*), wherein the mobile equipment comprises private content stored on the internal memory of the mobile equipment (*PIN code, a user phone book, and other data which can be anything else stored on the internal memory of the mobile equipment*), and further wherein the private content, or a pre-determined portion thereof, is associated with IMSI and MSISDN information unique to an owner (*subscriber*) of the private content or the pre-defined portion of the private content (*Paragraph 0005: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), which uniquely identifies the subscriber, a subscriber private-key, a copy of the user PIN code (private content), a user phone book same as group of contact information, and other data which can be discreet items such as MP3 file, a jpeg image, or a ring tone*); and

at least one SIM containing subscriber information and service or application profiles (*subscriber private-key, a copy of the user PIN code (private content), a user phone book same as group of contact information, and other data*), wherein the SIM identifies the subscriber by IMSI and MSISDN information stored on the SIM (*Paragraph 0005: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI)*);

wherein access to all or to the pre-defined portion of the private content occurs only when the IMSI/MSISDN information of the SIM correlates (*matches*) to the IMSI/MSISDN information of the private content (*user must enter their PIN for comparison by the SIM with the stored PIN value*), or of the pre-defined portion of the

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private content, stored in the memory of the mobile equipment (*Paragraphs 0005 and 0006*).

Regarding claims 17 and 19, Croome teaches the system, wherein the private content comprises one or more of the following items: (a) one or more ring tones, (b) one or more games, (c) one or more images, (d) one or more video files, or (d) one or more audio files (*Paragraph 0005: Croome teaches the SIM holds a variety of information including the International Mobile Subscriber Identity (IMSI), which uniquely identifies the subscriber, a subscriber private-key, a copy of the user PIN code, a user phone book same as group of contact information, e.g. phone numbers, and other data which can be discreet items such as MP3 file, a jpeg image, or a ring tone*).

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Asunmaa et al. (US Patent Application Publication #20030172090) teaches virtual identity apparatus and method for using same.

Waugh et al. (US Patent #6,324,402) teaches integration scheme for a mobile telephone.

Lu et al. (US Patent #5,818,824) teaches private multiplexing cellular network.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic E. Rego whose telephone number is 571-272-8132. The examiner can normally be reached on Monday-Friday, 8:30 am-5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 571-272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dominic E. Rego



NAY MAUNG
SUPERVISORY PATENT EXAMINER